

Remarks:

This application has been reviewed carefully in view of the Office Action mailed March 3, 2006 ("the Office Action"). In the Office Action, claims 1-3, 7-9 and 14-15 were rejected under 35 U.S.C. § 102(b), as allegedly being anticipated by McKay, U.S. Patent No. 6,434,808. Applicants note with appreciation that claims 4-6 and 10-13 were objected to, but found to be allowable if rewritten in independent form, including all of the limitations of the base claims and any intervening claims.

The above-described objections and rejections are addressed as follows:

I. REJECTION OF CLAIMS 1-3, 7-9 AND 14-15

As noted above, claims 1-3, 7-9 and 14-15 were rejected under 35 U.S.C. § 102(b), as allegedly anticipated by McKay. Applicants respectfully traverse this assertion.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *See*, M.P.E.P. § 706.02, citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Claim 1 recites:

A swaging tool, comprising:
a housing configured for a first swaging engagement member;
a *piston rod configured to remain stationary* with respect to the housing;
a *piston configured to translate along the piston rod*, the piston configured for a second swaging engagement member; and
an actuator configured to drive the piston along the piston rod such that the second engagement member moves toward the first engagement member.

The patent to McKay neither teaches nor discloses a swaging tool with a piston rod configured to remain stationary, nor comprising a piston configured to translate along the

piston rod. Rather, McKay discloses a piston affixed to a structure (connecting member 70), whose axial translation is guided by inner walls of internal bore 26, and thus the inner bore walls react non-axial loads imparted by the moveable portion 40, as can be seen in FIG. 1 and discussed in Col. 3, lines 38-45 of McKay.

5

In contrast, Applicants' claimed invention comprises a piston which translates on a piston rod as can be seen in FIG. 2 through FIG. 4. The piston rod preferably reacts non-axial loads imparted by the piston onto the rod.

10

Claim 15 likewise recites the features of a piston and piston rod, with the piston being driven axially along the piston rod, thereby also distinguishing claim 15 over the cited patent to McKay.

15

20

Because the cited art fails to disclose a swaging tool with a piston rod configured to remain stationary, and further fails to disclose a swaging tool with a piston configured to translate along the piston rod as recited in claim 1, the Office Action fails to establish a *prima facie* case of anticipation. As noted, claim 15 also recites a similar limitation of a piston translating axially along a stationary piston rod. Claim 7 recites a swaging method using the swaging tool of claim 1, and claims 8, 9 and 14 recite a swaging system using the swaging tool of claim 1, and thus, claims 7-9 and 14 incorporate all the limitations of claim 1. Accordingly, the rejection of claims 1-3, 7-9 and 14-15, and hence the objection to claims 4-6 and 10-13 which depend from claims 1-2 and 8-9 respectively, under 35 U.S.C. § 102(b) are improper, and Applicants respectfully request they be withdrawn.


25

II. CONCLUSION

In view of the foregoing, Applicants respectfully request that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

PALEJWALA et al.

By: 
John A. Griecci
Registration No. 39,694
For: The Law Office of John A. Griecci

703 Pier Avenue, Suite B #657
Hermosa Beach, CA 90254
(310) 376-6527